

REMARKS/ARGUMENTS

Claims 1-120 are pending in the present application.

This Amendment is in response to the Office Action mailed August 12, 2003. In the Office Action, the Examiner rejected claims 1-120 under 35 U.S.C. §103(a). Applicant has amended claims 1, 4, 7, 9, 11, 14, 21, 24, 54, 57, 60, 61, 71, 81, 91, 101, and 111.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

1. In the Office Action, the Examiner rejected claims 1-4, 7-14, 17-22, 24-36, 38-52 and 54-120 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,124,806 issued to Cunningham et al. ("Cunningham") in view of U.S. Patent No. 5,835,907 issued to Newman ("Newman") and claims 5-6, 15-16, 23, 37 and 53 under 35 U.S.C. §103(a) as being unpatentable over Cunningham in view of Newman and further in view of U.S. Patent No. 5,544,225 issued to Kennedy, III et al. ("Kennedy"). Applicant respectfully traverses the rejection and contend that the Examiner has not met the burden of establishing a prima facie case of obviousness.

Applicant reiterates the arguments set forth in the previously filed Response to the Office Action.

Cunningham discloses a wide area remote telemetry to obtain information on consumer utility usage. A sensor interface module sends the customer demand and usage information to data collection modules over unlicensed radio frequency bands (Cunningham, col. 4, lines 54-58). The data collection modules transmit the information over a data module connection to a network system (Cunningham, col. 4, lines 58-62). The network system forwards the information to a host module where the information is stored and processed (Cunningham, col. 7, lines 19-27).

Newman discloses an emergency personal communication services (PCS) system for identification and notification of a subscriber's location. An emergency PCS device receives signal transmission from several GPS satellites, converts the received signals information identifying a location of the emergency PCS device, and transmits the location and a code to a network over a wireless medium (Newman, col. 2, lines 21-29). If the emergency distress signal

has not been activated, a voice processing system provides on-demand information on the subscriber's location to a telephone caller (Newman, col. 2, lines 43-46). There is no activation message being sent in response to a telephony call.

Kennedy discloses data messaging in a cellular communications network. Voice/data links support transmission of data over a voice channel using a modem, dual-tone multifrequency (DTMF) tones (Kennedy, col. 6, lines 1-3).

Specifically, Applicant contends that Cunningham merely discloses the transmission of the usage information from the sensor interface module to the data collection module, then to the host module, and finally to the customer interface. When in the receive mode, the data collection module continuously scan a frequency based searching for a radio frequency signal (Cunningham, col. 20, lines 20-24). In the transmit mode, the data collection module uploads the information to the host module on a periodic time basis, at a preset time, or in response to a demand from the host module (Cunningham, col. 32, lines 29-34). Therefore, Cunningham is teaching away from the invention. First, Cunningham does not disclose or suggest sending an activation message in response to a telephony call. In the Office Action, the Examiner states that the sensor interface module is an activator which transmits the information over unlicensed radio frequency bands (Office Action, page 3, lines 4-6). Applicant respectfully disagrees. The sensor interface module sends the information, not an activation message. Second, Cunningham, does not disclose or suggest transmitting a signal modulated from an information message to a receiver in response to the activation command.

In the Office Action, the Examiner states that the data collection module generates an activation command by sending the information to the host module (Office Action, page 3, lines 6-8), but contradicts himself by stating that the data collection module transmits the information to the host module (Office Action, page 3, lines 9-12). The activation command is not the same as the information message.

Furthermore, Cunningham cannot be modified according to the teachings of Newman because remote telemetry periodically sends information to the host, not sending information to a server in response to a telephone call. Modifying Cunningham would render the technique unsatisfactory for its intended purpose. Therefore, there is no suggestion or motivation to make the proposed modifications.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01.

The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion or motivation to combine the references. "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re ROUFFET, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985).

In the present invention, the cited references do not expressly or implicitly suggest sending an activation message in response to a telephone call and transmitting/receiving an information message responsive to an activation command. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Cunningham, Newman and Kennedy is an obvious application of such an automatic communication mode.

Cunningham, Newman, and Kennedy, taken alone or in any combination, does not disclose, suggest, or render obvious (1) a decoder to decode an activation message, (2) the activation message being sent from an activator in response to a telephony call, (3) the decoder generating an activation command, (4) a transmitter/receiver to transmit/receive an information message responsive to the activation command.

The sensor interface module or the data collection modules disclosed in Cunningham are neither decoder nor activator. The sensor interface module merely sends customer demand and usage information. The data collection modules merely transmit the received demand/usage information to a network. There is no activation message in response to a telephony call.

Newman does not disclose the activation message being sent from an activator in response to a telephony call. Newman merely discloses a voice processing system to provide the information.

There is no motivation to combine Cunningham, Newman, and Kennedy because neither of them addresses the problem of automatic remote communication. There is no teaching or suggestion that a decoder to decode activation message is present. Cunningham, read as a whole, does not suggest the desirability of decoding an activation message, sending the activation message in response to a telephone call, generating a command, and transmitting/receiving an information message responsive to the command.

Therefore, Applicant believes that independent claims 1, 11, 21, 38, 54, 57, 60, 61, 71, 81, 91, 101, 111 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection(s) under 35 U.S.C. §103(a) be withdrawn.

Conclusion

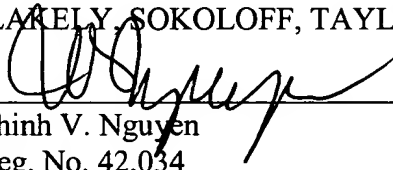
Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLARELY SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 12/10/2003

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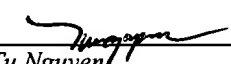
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